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Remarks

This amendment is responsive to the Official Action (non-final) mailed September 28, 2004. Claims 1 through 8 and 10 through 12 are pending in the application.

Claims 5 and 6 have been rejected under 35 USC 112, second paragraph, in that the scope of a CCK-A disease or conditions is indefinite (Official Action, paragraph 1). Accordingly, claims 5 and 6 have been amended to recite specific diseases or conditions, thereby rendering this rejection of the claims moot.

Applicants' attorney acknowledges that the Official Action, paragraphs 2-4 point out that rejections previously made are now withdrawn.

The Official Action (paragraph 5) maintains the obviousness rejection under 35 USC 103 in view of U.S. Patent No. 5,646,140 (Sugg, et al.). It is the Examiner's position that (1)'140 specifically discloses how to prepare seven compounds of which one is the applicant's compound i.e. example 7 and (2) example 1 discloses the process of separating the enantiomers of racemic compounds using chiral hplc.

This rejection of the claims is improper. It is only the impermissible use of hindsight gained from Applicants' present patent application that has led the Examiner to assert the '140 patent. As the Examiner has stated, the '140 patent prepares seven compounds. However, many more compounds than these seven are described and taught in the '140 patent. Further, example 7 is not applicant's claimed compound as alleged by the Examiner. Example 7 is the racemate. While the '140 patent discloses how one skilled in the art may separate a racemate into its enantiomeric components, there is no suggestion in the '140 patent that the (+)-enantiomer of the racemate of Example 7, in

particular, should be selected and separated. This selection is only taught in the present application. Accordingly, it is respectfully requested that this rejection of the claims be reconsidered and withdrawn.

The rejections in the Official Action (paragraphs 6-8) are now moot in view of the terminal disclaimer filed with this response. It is respectfully requested that the Examiner reconsider and withdraw these rejections of the claims in light of the terminal disclaimer.

In paragraph 9 of the Official, Claims 10-12 have been rejected under 35 USC 112, second paragraph, for the following reasons:

(a) For claims 10-12, it is not known what is meant by "optionally substituted" in the optionally substituted phenyl carbamate of formula (V);

(b) For claims 10-12, it is not known what is meant by the variable R_1, which is not defined within the claim;

(c) For claims 11 and 12, it is not known what is meant by "optionally substituted" in the optionally substituted benzyl group R_2;

(d) For claim 12, it is not known what is meant by a "derivative" which implies more than what is positively recited in the definition of the diacid (VIII).

In response to (a) and (b) above, Claim 10 has been amended to recite substituted groups (i.e., R_1) (basis, page 7, lines 5-10). In response to (c) above, R_2 has been defined based upon the specification at page 9, lines 10-11. And in response to (d) above, the activated derivative of the diacid (VIII) has been defined based upon the specification at page 10, lines 3-5). Accordingly, it is believed that this rejection of the claims is moot and should be reconsidered and withdrawn.

In view of the foregoing amendments and remarks, it is respectfully requested that the application be reconsidered and the claims as amended be allowed.

Respectfully submitted

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